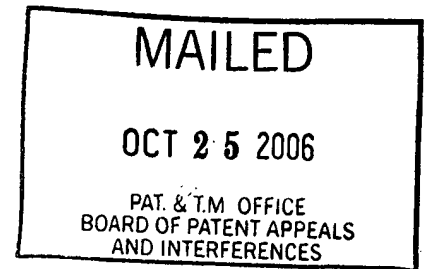


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE

Ex parte ORVALLE THEODORE KIRBY, GREGORY MICHAEL
NORDSTORM, GREGORY FRANCIS PFISTER, RENATO JOHN RECIO
and STEVEN MARK THURBER

Application 09/692,365



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on October 17, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

An Information Disclosure Statement (IDS) was filed June 22, 2005. It is not clear from the record whether the examiner considered the IDS or whether the examiner notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

A review of the file indicates that on November 18, 2005, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on November 18, 2005, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) ***Evidence appendix.*** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) ***Related proceedings appendix***. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed November 18, 2005:

- 1) "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix).
- 2) "Related proceedings appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

On February 28, 2006, an Examiner's Answer was mailed. A review of the Examiner's Answer reveals that it is not in compliance with the headings as required under MPEP § 1207.02

An in-depth review of the Examiner's Answer mailed on February 28, 2006, reveals that under the heading Evidence Relied Upon, the prior art relied on was not listed. The MPEP § 1207.02(A) states:

A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

(8) ***Evidence Relied Upon***. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Proper correction of the Examiner's Answer is required.

Accordingly, it is ORDERED that the application is return to the Examiner:

- 1) to consider the Information Disclosure Statement filed June 22, 2005;
- 2) provide appropriate written notification by the examiner to appellants of such consideration; and
- 3) hold the Appeal Brief filed on November 18, 2005, defective;
- 4) notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37 or for the examiner to present a statement regarding the position taken on the missing appendices;
- 5) if necessary, vacate the Examiner's Answer mailed February 28, 2006, and issue a revised Examiner's Answer in response to the supplemental

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Appeal Brief, and submit a revised Examiner's Answer in accordance with the new rules effective September 12, 2004; and

6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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